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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,466	06/12/2001	Jerry A. Pickering	10013	4348

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EXAMINER

HU, HENRY S

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

LD

**Supplemental
Notice of Allowability**

Application No.

09/879,466

Applicant(s)

PICKERING ET AL.

Examiner

Henry S. Hu

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Comments on Statement of Reasons for Allowance, September 23, 2004.
2. ☒ The allowed claim(s) is/are 16-33.
3. ☒ The drawings filed on 24 November 2003 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

DETAILED ACTION

1. Applicants' **Comments on Statement of Reasons for Allowance** filed on **September 23, 2004** was received. Applicants' **request for review of patent term adjustment** filed on **September 23, 2004** was also received. It is noted that the Applicants have already paid the issue fee on September 23, 2004. This office action is thereby only supplemental to the Notice of Allowance filed on June 17, 2004. In view of the Applicants' argument, the examiner has made some response with marking of " " as following:

Response to Applicants' Comments

2. The limitation of parent **Claim 16** of present invention relates to *a composition comprising (A) at least one fluoroelastomer, and (B) amorphous silica in aggregate form, surface treated with at least one organoaminosilane. Parent Claim 24 relates to a process of preparing a coating composition for using on surface contacting member by "mixing at least one fluoroelastomer and the amorphous silica (surface treated with organoaminosilane)" in a "bisphenol" curable system; while other parent Claim 30 relates to the composition of Claim 1 "but with amorphous silica which is surface treated with a specific silazane and not in aggregated form". See other limitations of dependent Claims 17-23, 25-29 and 31-33.*

Art Unit: 1713

3. In view of the Applicants' comments on pages 1-8, the Applicants allege that some of the limitations for Claims 24 and 30 are wrong or not completely recited. In response, the examiner has made corrections as (A) Parent **Claim 24** is related to a process of preparing a coating composition for using on surface contacting member by **"mixing at least one fluoroelastomer and the amorphous silica (surface treated with organoaminosilane)" in a "bisphenol" curable system** (see page 27 at paragraph 0112); and (B) parent **Claim 30** is related to the composition of Claim 1 **"but with amorphous silica surface treated with a silazane as specified and it is not in aggregated form"**.

4. Parent **Claim 16** of present invention is specifically related to "a composition comprising (A) at least one **fluoroelastomer**, and (B) amorphous **silica in aggregate form, surface treated with at least one organoaminosilane**". It is clear that **the compositions mentioned in three parent Claims 16, 24 and 30 are similar but not exactly the same.**

5. The Applicants have disclosed that **with the presence of "bisphenol crosslinker" and requisite accelerator, the claimed fluoroelastomer composition in a solvent would not render permanent any gels due to the "instability of gel" in the presence of such a curing system** (page 27 at paragraph 0112).

6. With respect to the key argument on different curing system of parent **Claim 24** in 103 rejection, both primary references, Cole or Winnik, are silent about including "the claimed **bisphenol crosslinking agents**" to make a curable composition. Both secondary references,

Art Unit: 1713

Grootaert or Chen only teach that fluorinated elastomers or polymers can be incorporated in a mixture including a polyhydroxy compound, an organo-onium compound and a metal oxide or hydroxide an acid acceptor such as MgO and Ca(OH)₂ to become curable due to a crosslinking mechanism.

7. However, a **linking motivation is lacked due to different applications as pointed out by the Applicants in pages 20-22 of amendment**. Additionally, **“the polyhydroxy curing system is somewhat different from the claimed bisphenol curing system”**. Therefore, none of the above references, alone or in combination, teaches or fairly suggests the present invention. It is noted that different crosslinked or vulcanized product would be thereby obtained by using different curing system.

8. It is noted that newly added parent **Claim 30** is relating to the limitation of Claim 16, **but with amorphous silica surface treated with a silazane as specified and it is not in aggregated form**. Additionally, the present invention has shown in examples along with some comparative examples for unexpected results in obtaining a surface contacting member coating composition as claimed in Claims 16 and 24 with a **“bisphenol curable system”** (see pages 39-53 for **examples 1-8 along with its control examples 1-10, and Tables 1-2**). Therefore, all the above-mentioned references, in combination or alone, does not teach or fairly suggest the limitations of present invention.

Art Unit: 1713

9. The three key issues, the specific limitation on (A) “a composition comprising at least one **fluoroelastomer**, and the amorphous **silica in aggregate form** and surface treated with at least one **organoaminosilane**” (Claim 16), (B) using “a process of preparing a surface contacting member coating composition **with bisphenol curable system**” (Claim 24), and (C) Claim 30 is relating to the limitation of Claim 16, **but with amorphous silica surface treated with a silazane as specified and it is not in aggregated form**” cannot be overcome by any or the combination of the above references, therefore, the present invention is novel.

10. As of the date of this office action, the examiner has not located or identified any reference that can be used singularly or in combination with another reference including the above references to render the present invention anticipated or obvious to one of the ordinary skill in the art. Therefore, the three independent and parent **Claims 16, 24 and 30** are allowed for the reason listed above. Since the prior art of record fails to teach the present invention, the remaining pending dependent **Claims 17-23, 25-29 and 31-33** are passed to issue.

11. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance".

Art Unit: 1713

12. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Henry S. Hu whose telephone number is (571) 272-1103. The examiner can be reached on Monday through Friday from 9:00 AM –5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Henry S. Hu

Patent Examiner, Art Unit 1713, USPTO

March 7, 2005



DAVID W. WU
SUPERVISORY PATENT EXAMINER
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